



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,977	12/10/2001	Michael Evan Webber	260/289	3321

34026 7590 09/29/2005

JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

EXAMINER

NASSER, ROBERT L

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/014,977
Filing Date: December 10, 2001
Appellant(s): WEBBER, MICHAEL EVAN

MAILED

SEP 29 2005

Group 3700

Coe Bloomberg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/29/2005 appealing from the Office action mailed 5/19/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3830630	Kiefer	8-1974
5376555	Forrester et al	12-1994
4582068	Phillipps et al	4/1986
6192261	Gratton et al	2-2001
6038913	Gustaffson et al	3-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The examiner notes that in the rejection to claims 20, 21, 22, 24-26, 29, 30, 32-34, 36, 37, 39, 41, and 42, that Culver was inadvertently listed as the reference. The reference should have been Phillipps, which was clear, since the rejection stated "as applied to claims 1, 4-6, 8, 10, 11, 13, 14, 17, and 19 above."

Claims 1, 4-6, 8, 10, 11, 13, 14, 17, and 19 are rejected under 435 U.S.C. 103(a) as being obvious over Kiefer et al 3830630 in view of Forrester et al 537655 and Phillipps et al 5482068. With respect to claims 1, 4-6, 8, 10, 11, 13, 14, 17 and 19, Kiefer teaches method of analyzing alveolar breath by expiring breath into a chamber, continuously monitoring the concentration of carbon dioxide in the expired breath with a detector 17, and when the carbon dioxide level reaches 4.5%, triggering the measurement of alcohol concentration in the alveolar breath. Neither the carbon dioxide

Art Unit: 3736

nor the alcohol measurements are done optically. Forrester et al further teaches a similar measuring arrangement using the carbon dioxide concentration to trigger the measurement of alcohol concentration, where both the carbon dioxide and alcohol levels are done optically. Hence, it would have been obvious to modify Kiefer et al to use optical measurements, as it is merely the substitution of one known equivalent sensing method for another. The combination does not base the trigger threshold on previous measurements. Phillipps et al a breath monitoring device where a threshold is updated based on only the immediately previous patient measurement, to tune the device to the particular patient. Hence, it would have been obvious to modify the above combination to update the threshold based on previous measurements, in order to allow the device to be fine tuned to each patient.

Claims 20, 21, 22, 24-26, 29, 31-34, 36, 37, 39, 40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiefer et al in view of Forester et al and Phillipps et al as applied to claims 1, 4-6, 8, 10, 11, 13, 14, 17, and 19 above, and further in view of Gratton et al 6192261. With regard to claims 20, 21, 22, 24-26, 29, 31-34, 36, 37, 39, 40, and 42, the only remaining difference is that applicant recites that the two light signals are multiplexed. Gratton et al teaches in figure 4, that which is well known in this field, i.e. that it is known to multiplex signals of different wavelengths for measurement. Hence, it would have been obvious to modify the above combination to multiplex the signals, as it is the substitution of one equivalent measurement technique for another.

Art Unit: 3736

Claims 1, 4-6, 8, 9, 11, 13, 14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Gustafsson et al 6038913 in view of Kiefer, Forrester et al and Phillipps et al. With respect to claims 1, 4-6, 8, 9, 11, 13, 14, 17 and 18, Gustafsson teaches a method of measuring NO in alveolar air using spectrophotometric techniques. It does not teach a method of ensuring that only alveolar breath components are measured. Kiefer teaches method of analyzing alveolar breath by expiring breath into a chamber, continuously monitoring the concentration of carbon dioxide in the expired breath with a detector 17, and when the carbon dioxide level reaches 4.5%, triggering the measurement of alcohol concentration in the alveolar breath. The carbon dioxide measurement is not done optically. Forrester et al further teaches a similar measuring arrangement using the carbon dioxide concentration to trigger the measurement of alcohol concentration, where the carbon dioxide levels are measured optically. Hence, it would have been obvious to modify Kiefer et al to use optical measurements, as it is merely the substitution of one known equivalent sensing method for another. The combination does not base the trigger threshold on previous measurements. Culver et al teaches a breath monitoring device where a threshold is update based on previous patient measurements, to tune the device to the particular patient. Hence, it would have been obvious to modify the above combination to update the threshold based on previous measurements, in order to allow the device to be fine tuned to each patient.

Claims 20, 21, 22, 24-26, 29, 30, 32-34, 36, 37, 39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafsson et al in view of Kiefer et al and Forester et al and Phillips et al as applied to claims 1, 4-6, 8, 9, 11, 13, 14, 17,

Art Unit: 3736

and 18 above, and further in view of Gratton et al. With regard to claims 20, 21, 22, 24-26, 29, 30, 32-34, 36, 37, 39, 40, and 41, the only remaining difference is that applicant recites that the two light signals are multiplexed. Gratton et al teaches in figure 4, that which is well known in this field, i.e. that it is known to multiplex signals of different wavelengths for measurement. Hence, it would have been obvious to modify the above combination to multiplex the signals, as it is the substitution of one equivalent measurement technique for another.

(10) Response to Argument

Appellant has asserted that there is no suggestion to combine the references. Specifically, Appellant asserts that Phillips does not measure two components of breath or any component of breath and therefore there is no suggestion to combine Phillips with the references. The examiner disagrees. The only feature not shown by the Kiefer and Forrester combination is to update the threshold based on the previous measurement. It is well known in the medical field to update the thresholds based on the previous measurement(s) so as to tune the measurement circuit to measurement to the anomalies of each individual patient. The Federal Circuit has made it clear that a reference is good for all it teaches. Here, Phillips simply teaches what is well known, i.e. updating a threshold based on a previous measurement, to tune the device to the individual patient. The motivation to modify comes from Phillips as well as the general knowledge in the art.

Art Unit: 3736

Appellant has further asserted that the examiner has engaged in hindsight. The examiner disagrees, noting that no impermissible hindsight has been used.

Appellant has further argued that by using a fixed threshold, Kiefer and Forrester teach away from the modification. The examiner disagrees. Teaching away means that the reference teaches it would not function if the modification were made. Nowhere does Kiefer or Forrester teach that the reference wouldn't work if the threshold were modified. Therefore, it is the examiner's position that the references do not teach away from the combination.

Appellant further asserted that Kiefer would need to be modified to accommodate the changes. The examiner agrees, but notes that such changes are expected when proposing a modification under 35 USC 103 and are a matter of routine experimentation for one skilled in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Robert L. Nasser Jr.



ROBERT L. NASSER
PRIMARY EXAMINER

Conferees:



Michael Peffley



Angela Sykes